THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK BERNARDI
and SOL M. CHERRICK

Appeal No. 1997-3847
Application 08/569,636

ON BRIEF

Before HAIRSTON, KRASS, and GROSS, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 2 through 14, all of the claims pending in the application.

The invention pertains to television viewing. More particularly, the remote control accesses only desired channels with the up/down keys when the receiver is placed in a surf operating mode. The surf channels are selected as a subset of channels in the television receiver memory which are normally sequentially accessed by operation of the up/down keys on the remote control.

Representative independent claim 8 is reproduced as follows:

8. A television receiver having a surf tuning mode comprising:

tuning means for tuning to a plurality of television channels by direct input of channel numbers;

memory means for storing channels in a television receiver memory for enabling sequential tuning of channels with up/down channel keys;

menu means for denominating selected television channels as memory channels and desired ones of said selected channels as surf channels in said memory means; and

means for activating said surf mode wherein sequential tuning with the up/down channel keys is only among channels denominated as surf channels.

The examiner relies on the following references:

Young et al. (Young)	5,353,121	Oct. 4, 1994
O'Donnell et al.	5,414,426	May 9, 1995

(O'Donnell)

Miller et al. (Miller)	5,585,866	Dec. 17, 1996 (filed Jun. 7, 1995)

"StarSight" (StarSight), A portion of the User's Manual for the Mitsubishi CS35803 Television Receiver, p. 2, 1995.

Claims 2, 8 and 12 stand rejected under 35 U.S.C. § 102(b) as anticipated by Young. Claims 3 through 7, 9 through 11, 13 and 14 stand rejected under 35 U.S.C. § 103 as unpatentable over Young in view of StarSight. Claims 2 and 8 stand further rejected under 35 U.S.C. § 103 as unpatentable over O'Donnell. In a new ground of rejection, entered in the answer, the examiner also rejected claims 2 through 14 under 35 U.S.C. § 103 as unpatentable over Miller.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

At the outset, we note that, in accordance with appellants' grouping at page 4 of the principal brief, all claims will stand or fall together.

We turn first to the rejection of claims 2, 8 and 12 under 35 U.S.C. § 102(b). The examiner has set forth, at pages 4-5 of the answer, the rationale behind the rejection,

indicating how the various portions of Young correspond to the claimed elements. It appears to us that the examiner has set forth a prima facie case of anticipation, shifting the burden to appellants to rebut the prima facie case with arguments or evidence.

Appellants argue that the StarSight system disclosed by the Young reference employs separate memories. Therefore, argue appellants, a viewer may have different sets of favorite channels in the television memory and the StarSight memory. We do not see how such separate memories would preclude the application of Young to instant claim 8, for example.

Appellants also argue that their "simple and inexpensive" system yields benefits not achieved by the StarSight system of Young. That may very well be the case but it is not clear how such an argument relates to any *claimed* limitations.

With regard to the dispute between appellants and the examiner as to the implications of the Young disclosure, at column 18, lines 29-33, that the controller "may be integrated into other television equipment, such as...a TV/Monitor receiver," appellants argue that such an integration "would

utilize the scheduling system memory as is--and not use the television receiver memory for these purposes" [principal brief-page 5]. Without any evidence to the contrary, we find ourselves in agreement with the examiner that the simple meaning of "integrated" would point to a system made whole. Therefore, whatever memory is being used to store channels, it is part of the same integrated system.

Appellants further argue, with regard to claim 2, but also applicable to claims 8 and 12, that the "television memory contains both the memory channels and the surf channels" [principal brief-page 5]. However, the examiner has treated this by using the teaching of Young, at column 18, lines 29-33, to imply that once there is one integrated system, the system, or television, memory contains both the memory and surf channels. If appellants are implying that the memory and surf channels of the instant invention are different, we disagree. While the instant disclosed invention certainly teaches that the surf channels may be less than, or a subset, of the total memory channels, the invention, *as claimed*, does not preclude the surf channels from being the

same as the memory channels, i.e., the subset of the memory channels which constitutes the surf channels may, in fact, be the same as the set of memory channels. That is the mathematical case where a universal subset may be a subset of itself. Note that the instant claims do not require the number of selected television channels as memory channels and the number of desired ones of the selected channels as surf channels in the memory means to be different. The desired number of surf channels may be *all* of the memory channels.

Accordingly, we will sustain the rejection of claims 2, 8 and 12 under 35 U.S.C. § 102(b).

Turning now to the rejection of claims 3 through 7, 9 through 11, 13 and 14 under 35 U.S.C. § 103, we will also sustain this rejection because claims 3 through 7, 9 through 11, 13 and 14 fall with claims 2, 8 and 12. As stated by appellants in the last full paragraph of page 6 of the principal brief, the features of the dependent claims are conceded to be unpatentable apart from their parent claims.

With regard to the rejection of claims 2 and 8 under 35 U.S.C. § 103 over O'Donnell, we will not sustain this rejection.

O'Donnell does disclose a remote controller for a television which enables a user to define a macro for selecting at least one favorite channel. However, O'Donnell does not disclose that these favorite channels may be accessed by use of the up/down keys. The examiner concedes that O'Donnell does not teach this feature but the examiner contends that any keys, with the exception of the number keys, may be used as the macro keys in O'Donnell. Therefore, concludes the examiner, it would have been obvious to employ the up/down keys for such a purpose. We disagree.

O'Donnell specifically teaches, at the bottom of column 4, that the macro keys are special keys, either especially labeled or colored, for their purpose. Thus, we do not find that the skilled artisan would have been led, from such a teaching, to discard the specific macro keys and use, in their stead, the up/down keys, giving them a dual function in addition to their regular use as a means for increasing or decreasing the channel number being selected. It would appear to us that the only teaching of this dual function for the up/down keys comes from appellants' own disclosure. That is

not a proper basis on which to conclude obviousness within the meaning of 35 U.S.C. § 103.

Finally, we turn to the rejection of claims 2 through 14 under 35 U.S.C. § 103 over Miller.

Again, we find that the examiner has set forth a prima facie case of obviousness, setting forth, at pages 9-10 of the answer, the reasoning behind the rejection and the correspondence between the claimed elements and those elements disclosed by Miller.

Appellants' arguments are similar to those supra. Appellants contend that Miller is "substantially the same" as the Young and StarSight references [reply brief-page 2]. To whatever extent Miller is similar, we have treated the rejections based on Young and/or StarSight and need not repeat our rationale here. Further, appellants argue that Miller's system "restricts tuning to a subset of the available channels..." [reply brief-page 2] whereas in appellants' surf mode, "tuning is among a subset of a subset of the available channels" [all emphasis appears in the original].

As we explained supra, appellants' argument fails to take into account the fact that a subset of a universal set of

elements may, in fact, constitute that universal set. A set is always a "subset" of itself. Accordingly, as long as Miller teaches tuning to a subset of the available channels, which appellants apparently concede, then that subset of channels (which, in appellants' disclosure, would be the memory channels), may also be considered the channels in surf mode because a user may choose to include all of the subset of available channels as the surf channels. We note, again, that appellants have included no requirement in the instant claims that the number of selected television channels as memory channels and the number of selected channels as surf channels in the memory means be different. The desired number of surf channels may be *all* of the memory channels.

While there may be arguments appellants might have made but did not, our decision is made based upon the arguments, in fact, presented by appellants. Arguments not made are waived. In re Kroekel, 803 F.2d 705, 709, 231 USPQ 640, 642-643 (Fed. Cir. 1986).

The rejections of claims 2, 8 and 12 under 35 U.S.C. § 102(b) as anticipated by Young, of claims 3 through 7, 9 through 11, 13 and 14 under 35 U.S.C. § 103 in view of Young

and StarSight, and of claims 2 through 14 under 35 U.S.C. § 103 over Miller have been sustained. The rejection of claims 2 and 8 under 35 U.S.C. § 103 over O'Donnell has not been sustained.

Accordingly, the examiner's decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Kenneth W. Hairston Administrative Patent Judge	)	
Errol A. Krass Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
Anita Pellman Gross Administrative Patent Judge	)	

tdl
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